



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,663	10/25/2000	Henry N. Holtzman	PRT-004	4174

21323 7590 08/29/2003

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,663

Applicant(s)

HOLTZMAN ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3621

DETAILED ACTION

Claims 1-17 remain pending.

Response to Arguments

The applicants arguments filed on June 12, 2003 have been fully considered.

Claims 1-17.

The Applicant states the Elliot reference was filed on November 8, 2000 and does not claim priority to any earlier applications.

The Examiner states the Elliot reference has been withdrawn.

The Applicant states the Janning reference does not teach or suggest "accessing customer data based on the identifier" and "identifying in the customer data a preferred payment method for the customer."

The Examiner states that these features are in the newly discovered reference O'Hagan et al. (US Patent 6,314,406).

See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janning et al. (US patent 6,446,049) in view of O'Hagan (US Patent 6,314,406).

As per claim 1,

Janning et al. ('049) discloses a computer-based method for selling an item to a customer at a retail location, the method comprising the steps of

receiving at the retail location an identifier associated with a token presented by a customer;(Column 8, lines 20-28)

preparing the identified customer order at the retail location;(Figure 1)

executing payment by the customer for the selected order by the preferred payment method;(Column 9, lines 59-67; column 10, lines 1-32)

Art Unit: 3621

providing the customer with the selected order at the retail location.(Column 10, lines 35-38)

Janning et al. ('049) does not explicitly disclose identifying in the customer data a preferred payment method for the customer. O'Hagan ('406) discloses identifying in the customer data a preferred payment method for the customer (Figure 18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan's teaching in order to more efficiently serve the customer.

Janning et al. ('049) does not explicitly disclose accessing customer data based on the identifier. O'Hagan ('406) discloses accessing customer data based on the identifier; (Figure 11) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan's teaching of identifying in the customer data a product order selected by the customer in order to more efficiently serve the customer.

Janning et al. ('049) does not explicitly disclose identifying in the customer data a product order selected by the customer. O'Hagan ('406) discloses identifying in the customer data a product order selected by the customer (column 20, lines 51-59) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan's teaching of identifying in the customer data a product order selected by the customer in order to more efficiently serve the customer.

As per claim 2,
Janning et al. ('049) discloses the method of claim 1,
wherein the token comprises an RFID tag, and step (a) comprises wirelessly reading a RFID tag presented by the customer.(Column 6, lines 15-42; also figure 1)

As per claim 3,
Janning et al. ('049) discloses the method of claim 2,
wherein the steps are performed in response to a single user action, the single user action comprising presenting the RFID tag to an RFID reader located in the retail location.(Column 8, lines 1-52, also figure 3)

As per claim 4,
Janning et al. ('049) discloses the method of claim 1,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location that the token comprises a magnetic stripe card, and step (a) comprises reading a magnetic stripe card presented by a customer to a magnetic stripe reader. It would be obvious to one having ordinary skill in the art at the time of the invention to utilize a magnetic card and reader because this is an inexpensive well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

As per claim 5,
Janning et al. ('049) discloses the method of claim 4,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location that the steps are performed in response to a single user action, the

Art Unit: 3621

single user action comprising presenting the magnetic stripe card to a customer accessible magnetic stripe card reader located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention that a single user action of presenting a magnetic stripe card to a card reader at a retail location would occur because this is an inexpensive and well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

As per claim 6,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose the steps of facilitating customer selection of a product order; and associating the customer selected product order with the customer. O'Hagan et al. ('406) discloses the steps of facilitating customer selection of a product order;(Figure 23) and associating the customer selected product order with the customer. (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of facilitating customer selection of a product order and associating the customer selected product order with the customer in order to more efficiently serve the customer.

As per claim 7,

Janning et al. ('049) discloses the method of claim 6,

Janning et al. ('049) does not explicitly disclose facilitating customer selection via the Internet. O'Hagan et al. ('406) discloses facilitating customer selection via the Internet; (Column 3, lines 16-24) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of facilitating customer selection via the Internet because the internet is an inexpensive and efficient medium to reach the customer.

As per claim 8,

Janning et al. ('049) discloses the method of claim 6,

Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to facilitate customer selection at a terminal located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention to facilitate customer selection at a terminal located in the retail location because this allows the customer to select items from the immediate inventory of the store and prevents aggravation caused by the necessity to order items.

As per claim 9,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data over the Internet. O'Hagan et al. ('406) discloses accessing customer data over the Internet; (Column 3, lines 16-24). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over the Internet because reduces the overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

Art Unit: 3621

As per claim 10,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data over a local area network. O'Hagan et al. ('406) discloses accessing customer data over a local area network; (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over a local area network because reduces the overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

As per claim 11,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data from a local database. O'Hagan et al. ('406) discloses accessing customer data from a local database. (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data from a local database because increased the reliability of the system by allowing information to be accessible even if the network is inoperable.

As per claim 12,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to access customer data from a database operated from a third party service provider. It would be obvious to one having ordinary skill in the art at the time of the invention to access customer data from a database operated from a third party service provider because this is a cost effective way to verify the credentials of customer. The examiner notes that this feature is routinely provided by credit rating services such as Equifax.

As per claim 13,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose providing payment information to a POS device for execution. O'Hagan et al. ('406) discloses providing payment information to a POS device for execution. (Figure 18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of providing payment information to a POS device for execution because this allows the merchant to realize a profit on the transaction

As per claim 14,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to process payment and provide an execution code indicating complete payment to a POS device. It would be obvious to one having ordinary skill in the art at the time of the invention to process payment and provide an execution code indicating complete

Art Unit: 3621

payment to a POS device because this allows the merchant to realize a profit on the transaction. The examiner notes that this feature is common to a majority POS systems.

As per claim 15,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location to obtain a count value associated with the token and if the count value is greater than zero, decrementing the count value. It would be obvious to one having ordinary skill in the art at the time of the invention to obtain a count value associated with the token and if the count value is greater than zero, decrement the count value because this encourages the customer loyalty. The examiner notes that this feature is common to promotional sales programs where the customer is "rewarded" after a certain number of purchases are made.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Patent 6,314,406) in view of Janning et al. (US patent 6,446,049).

As per claim 16,

O'Hagan et al. ('406) discloses a system for selling an item at a retail location, comprising the steps of

a dispatch module for accessing customer data based on the identifier, and for identifying in the customer data a selected customer order and a preferred payment method; (Figures 27 and 18)

a display for displaying the selected customer order at the retail location to a retail clerk; (Figure 18)

a POS device for executing payment by the customer for the selected customer order by the preferred payment method.(Figure 18)

O'Hagan et al. ('406) does not explicitly disclose a token reader for receiving at the retail location an identifier associated with token presented by the customer. Janning et al. ('049) discloses a token reader for receiving at the retail location an identifier associated with token presented by the customer. (Figure 16) It would be obvious to one having ordinary skill in the art at the time of the invention to combine O'Hagan et al.'s device with Janning's teaching of a token reader for receiving at the retail location an identifier associated with token presented by the customer in order to more efficiently serve the customer.

As per claim 17,

O'Hagan et al ('406) discloses the system of claim 16

further comprising a database server in communication with the dispatch module over a computer network for providing customer data in response to a request comprising an identifier.(Figure 17)

Conclusion

Art Unit: 3621

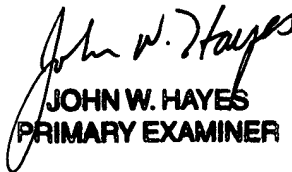
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

August 25, 2003


JOHN W. HAYES
PRIMARY EXAMINER